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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/993,429	11/13/2001	Nisheeth Ranjan	AOL0019	7537
22862	7590	07/10/2006	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			SHAPIRO, LEONID	
			ART UNIT	PAPER NUMBER
			2629	

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/993,429	RANJAN, NISHEETH	
	Examiner	Art Unit	
	Leonid Shapiro	2629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-23, 25-29, 31, 32 and 35-44 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-23, 25-28 and 38-42 is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-20, 29, 31, 32, 35-37, 43 and 44 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 43-44 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As to claim 43, it is not clear how far area above tip of pen is extending?

Claim 44 depends on claim 43.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4,6-10,14,16-20, 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. (200310169864) in view of Schiller et al. (US Patent No. 6,577,299 B1).

With regard to claim 1 Lapstun et al. teaches a method for wireless transmission of information from a first media to a second media (figure 8), comprising the steps of: entering said information on said first media (figure 8, item 504), wherein said first media comprises paper media (figure 2, item 1 section

(0049), wherein said information is entered via a Bluetooth-enabled pen (section 223); and transferring said information from said first media to said second media (figure 2, items 101 and 10), wherein said step of transferring couples said Bluetooth-enabled pen directly to a computer and via said computer to an online service provider (figure 87, items A, 503, section 0100 and section 0154), wherein said second media comprises online electronic media (figure 2, item 10, section (0052)). Lapstun also teach that the second media is an online duplicate of the first media (section [0092], where Lapstun shows that the ink is sensed by an optically imaging pen, and transmitted to the net page). This simply means that when the pen moves on the encoded paper, it reads the data and then transmitted to the second media via the netpage system, which means that the data sensed by the pen is duplicated.

Lapstun et al. does not disclose pen comprises a tip, and wherein pen comprises a hardware to capture motion of tip of pen.

Schiller et al. teaches pen comprises a tip, and wherein pen comprises a hardware to capture motion of tip of pen (See Fig. 1, items 112,115, Col. 3, Lines 55-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Schiller et al. teachings into Lapstun et al. system in order to determine absolute position on the pen (See Col. 1, Lines 51-66 in the Schiller et al. reference).

With regard to claim 2, Lapstun et al. teaches said Bluetooth-enabled pen (marking device) (section (0223)) further comprises: a receiver device and a transmitter device (section (0157)).

With regard to claim 3 Lapstun et al. teaches a method for wireless transmission of information from a first media to a second media (figure 8), comprising the steps of: entering said information on said first media (figure 8, item 504); and transferring said information from said first media to said second media via an ad-hoc network (figure 8, items 101, 503, A, section (0154). Lapstun also teach that the second media is an online duplicate of the first media (section [0092], where Lapstun shows that the ink is sensed by an optically imaging pen, and transmitted to the net page). This simply means that when the pen moves on the encoded paper, it reads the data and then transmitted to the second media via the netpage system, which means that the data sensed by the pen is duplicated.

Lapstun et al. does not disclose pen comprises a tip, capturing digitally motion of the pen.

Schiller et al. teaches pen comprises a tip, capturing digitally motion of the pen (See Fig. 1, items 112,115, Col. 3, Lines 55-65).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Schiller et al. teachings into Lapstun et al. system in order to determine absolute position on the pen (See Col. 1, Lines 51-66 in the Schiller et al. reference).

With regard to claim 4 Lapstun et al. teaches that the first media comprises paper media and the second media comprises electronic media (section [0049] and section [0052]).

With regard to claim 6 Lapstun et al. teaches that the first media comprises a paper book (section [0096]).

With regard to claim 7 Lapstun et al. teaches that the first media comprises a paper magazine (section [0096]).

With regard to claim 8 Lapstun et al. that the first media comprises a paper shopping catalog (section [0096]).

With regard to claim 9 Lapstun et al. teaches that the ad-hoc network is Bluetooth network (figure 8, items 101, 503, A, section [0154]).

With regard to claim 10 Lapstun et al. teaches that transferring the information comprises overlaying the information on the second media (figure 22 illustrates where you write a short message on paper whereby that information is overlay in the network and sent to a receiver).

With regard to claim 14 Lapstun et al. teaches that the entering the information comprises writing a note on a portion of the first media (figure 22 whereby it is inherent that a user is capable of using his pen this way when writing a message).

With regard to claim 16 Lapstun et al. teaches the step of providing a dictionary meaning for the selected word on the second media (figure 22 whereby it is inherent that a user is capable of writing the dictionary meaning of any word he writes down).

With regard to claim 17 Lapstun et al. teaches the method of claim 10, wherein the entering the information comprises filling up a form (figures 18 and 22).

With regard to claim 18 Lapstun et al. teaches that the form comprises a tax form [section (0096)].

With regard to claim 19 Lapstun et al. teaches that the form comprises a purchase order (section (0096))

With regard to claim 20 Lapstun et al. teaches the method of claim 4, wherein the electronic media comprises Internet-based media (section [0101]).

As to claim 29, Lapstun et al. teaches step of transferring does not transfer said information via a netpage printer to a phone (fig. 8, items 101, 503,A, section 0154).

3. Claims 11-13, 15, 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. and Schiller et al. in view of Montlick (US Patent No. 5,561,446).

As to claims 11-13, 15, Lapstun et al. and Schiller et al. do not disclose circling, underlining, highlighting and selecting a word on a portion of first media.

Montlick teaches circling an area on the illustration (See Figs. 5-7, item , 12b, 62a-62b, Col. 9, Lines 25-37).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Montlick teachings into Lapstun et al. and Schiller et al. system in order to collect handwritten information including , underlining, highlighting and selecting a word in real time from a pen-based computer using a wireless network (See Col. 2, Lines 42-45 in the Montlick reference).

As to claim 38, Montlick teaches first media does not consist of a netpage form (See Fig. 5, item 12c).

4. Claims 31-32, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapstun et al. in view of Want et al. (US Patent No. 6,008,727).

As to claims 31-32, Lapstun et al. and Schiller et al. do not disclose a radio-frequency tag with pen close to first media.

Want et al. teaches a radio-frequency tag with pen close to first media (See Fig. 1, items 32, 14, Col. 7, Lines 38-56 and from Col. 8, Line 66 to Col. 9, Line 6).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate Want et al. teachings into Lapstun et al. and Schiller et al. system in order to identify different device (See Col. 1, Lines 62-67 in the Want et al. reference).

As to claims 35-37, Lapstun et al. teaches pen is Bluetooth enabled and step of transferring couples said Bluetooth-enabled pen to an online service provider via a computer (section 0223).

Allowable Subject Matter

2. Claims 21-23, 25-28, 38-42 are allowed.

Relative to independent claim 21 the major difference between the teaching of the prior art of record (Lapstun et al. and Schiller et al.) and the instant invention is that pen captures video of an area about half an inch above tip of pen.

Claims 22-23,25-28,39-42 depend on claim 21.

Response to Arguments

2. Applicant's arguments with respect to claims 1-4,6-20,29,31-32,35-37,43-44 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Telephone Inquire

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Leonid Shapiro whose telephone number is 571-272-7683. The examiner can normally be reached on 8 a.m. to 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe can be reached on 571-272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LS
06.29.06



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